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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,585	07/11/2003	Donald Albert Paquet JR.	FA1048	3692

23906 7590 10/20/2005

E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
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EXAMINER	
CHEUNG, WILLIAM K	

ART UNIT	PAPER NUMBER
1713	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/617,585	PAQUET ET AL.	
	Examiner	Art Unit	
	William K. Cheung	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 August 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) *22-25* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21, 26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-26 are pending. Claims 22-25 are drawn to non-elected subject matter. Claims 1-21, 26 are examined with merit.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-21, 26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/109,948, claims 1-10 of copending Application No. 10/120,127, and claims 1-10 of copending Application No. 10/109,947. Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention of claims 1-21, 26 of instant application are related to claims 1-10

of copending Application No. 10/109,948, claims 1-10 of copending Application No. 10/120,127, and claims 1-10 of copending Application No. 10/109,947, as genus and its speices.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-21, 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,558,745, claim 1 of U.S. Patent No. 6,562,893, and claim 1 of U.S. Patent No. 6,551,712. Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention of claims 1-21, 26 of instant application are related to claims 1-10 of copending Application No. 10/109,948, claims 1-10 of copending Application No. 10/120,127, and claims 1-10 of copending Application No. 10/109,947, as genus and its species.

Applicant's arguments filed August 17, 2005 have been fully considered but they are not persuasive. Applicants argue that the claimed invention is different as compared to the inventions of claims 1-10 of copending Application No. 10/109,948, claims 1-10 of copending Application No. 10/120,127, claims 1-10 of copending Application No. 10/109,947, claim 1 of U.S. Patent No. 6,558,745, claim 1 of U.S. Patent No. 6,562,893, and claim 1 of U.S. Patent No. 6,551,712 because of the differences in chemical compositions. However, applicants fail to recognize that the argued differences in

chemical compositions are not supported by the claims of instant application or in claims 1-10 of copending Application No. 10/109,948, claims 1-10 of copending Application No. 10/120,127, claims 1-10 of copending Application No. 10/109,947, claim 1 of U.S. Patent No. 6,558,745, claim 1 of U.S. Patent No. 6,562,893, and claim 1 of U.S. Patent No. 6,551,712. Therefore, the ODP rejections set forth are proper.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 (line 1), the recitation of "non-functional" is considered indefinite because the monomers cited within the Markush group contains species having various functional groups such as phenyl, fluoro, bicyclic, polycyclic, and aromatic with 2-3 rings functional groups.

Applicant's arguments filed August 17, 2005 have been fully considered but they are not persuasive. Applicants argue that "non-functional" is definite because it is defined in applicants' specification. However, applicants fail to recognize that even the law allows applicants to be his own lexicographer in defining some specific terms that

are not known in the art, applicants must recognize that the definitions provided by applicants must not violate the general teachings of the terminologies in the art. As for the instant case, applicants are defining functional groups such as phenyl, fluoro, bicyclic, polycyclic, and aromatic with 2-3 rings functional groups as "non-functional" clearly violates the common terminology understanding in the art of coating compositions. Therefore, the rejection set forth is proper.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-16, 18-21, 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Barkae et al. (US 6,339,126 B1) for the reasons adequately set forth from paragraph 9 of non-final office action of April 13, 2005.

Applicant's arguments filed August 17, 2005 have been fully considered but they are not persuasive. Applicants argue that "non-functional" is definite because it is defined in applicants' specification. However, applicants fail to recognize that even the law allows applicants to be his own lexicographer in defining some specific terms that are not known in the art, applicants must recognize that the definitions provided by

applicants must not violate the general teachings of the terminologies in the art. As for the instant case, applicants are defining functional groups such as phenyl, fluoro, bicyclic, polycyclic, and aromatic with 2-3 rings functional groups as "non-functional" clearly violates the common terminology understanding in the art of coating compositions. Therefore, the 102 rejection set forth is proper.

Allowable Subject Matter

9. Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and that the ODP rejection is overcome.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William K. Cheung

Primary Examiner

WILLIAM K. CHEUNG
PRIMARY EXAMINER

October 14, 2005